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In re Application of :
Ben Achour et al. :
Application No. 10/733,232 : ON APPLICATION FOR
Filed: December 12, 2003 : PATENT TERM ADJUSTMENT
Atty Docket No. 3495.0381-00 :

This is in response to the APPLICATION FOR PATENT TERM ADJUSTMENT-PRE-GRANT filed December 19, 2008. Applicants submit that the correct patent term adjustment to be indicated on the patent is two hundred sixty-six (266) days, not zero (0) days as calculated at the time of the mailing of the notice of allowance. Applicants request this correction in part on the basis that the Office will take in excess of three years to issue this patent¹.

To the extent that the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not

¹ It is noted that a request for continued examination (RCE) was first filed in this application on June 25, 2007. An RCE cuts-off their ability to accumulate any additional patent term for over three year pendency. The 1.702(b) period excludes any period consumed by continued examination requested by applicant under 35 U.S.C. 132(b).

undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee².

To the extent that applicant otherwise requests correction of the patent term adjustment at the time of mailing of the notice

² For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the § 1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

of allowance, the application for patent term adjustment is **DISMISSED**.

On September 26, 2008, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 0 days. On December 22, 2008, applicant timely submitted the instant application for patent term adjustment³. Applicant maintains that an additional period of adjustment should be entered as the Office mailed a first Office action in response to applicant's request for continued examination filed June 25, 2007 on September 7, 2007, but then withdrew that Office action and mailed a corrected Office action on March 4, 2008. Applicant asserts entitlement to an adjustment of 130 days for Office delay for the period from the date four months from the filing date of the RCE, October 25, 2007, to the date of mailing of the corrected Office action, March 4, 2008.

Applicant states that the above-identified application is not subject to a terminal disclaimer.

Applicant's argument has been considered, but not found persuasive. A notification under 35 U.S.C. 132 was mailed on September 7, 2007. Thereafter, a second notification under 35 U.S.C. 132 was mailed on March 4, 2008. The mailing of a second Office action withdrawing the first action does not negate the fact that the Office took action in this application within the meaning of § 1.702(a)(2) on September 7, 2007. Accordingly, entry of an additional period of adjustment of 130 days for Office delay in mailing a further notification is not warranted.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

The application is being forwarded to the Office of Data Management for issuance of the patent. The patent term

³ PALM records indicate that the issue fee was also paid on December 22, 2008.

adjustment indicated on the patent will include any additional patent term adjustment accrued for Office delay in issuing the patent after payment of the issue fee and all outstanding requirements having been met.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.

A handwritten signature in black ink, appearing to read "Nancy Johnson", is written over the typed name.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions